

### **REMARKS**

As a result of this response, claims 39, 40, 44-56, 88-91 are now pending in this application. Applicant notes that claims 42, 43, and 57 were canceled in the previous amendment, mailed on November 1, 2001.

### **Reservation of Rights**

Applicant reserves the right to rebut any tacit or explicit characterization of the references to the extent the following remarks do not. Additionally, applicant reserves any available right not exercised herein, including, for example, the right to swear behind any cited reference and the right to assert co-ownership of one or more of the cited references.

### **Information Disclosure Statement**

Applicant respectfully requests that an initialed copy of the 1449 Form for the Information Disclosure Statement filed on October 10, 2000, acknowledging consideration of the cited references, be returned with the next official communication.

### **Response to §112 Rejections**

The Action rejected claim 45 under 35 USC § 112, second paragraph, as indefinite, suggesting changing "between said first and said second portions" to "between said first and third portions." Applicant has amended the claims in accord with the suggestion to overcome to rejection.

Accordingly, applicant respectfully requests that the rejection be withdrawn.

### **Response to §102 Rejections**

Claims 39-57 and 88-92 were rejected under 35 USC § 102(e) as anticipated by Fazan (U.S. 5,392,189), and claims 39-47, 56-57, and 88-92 were rejected similarly as anticipated by Nishioka (U.S. 5,489,548).

In response, applicant notes that the effective filing date of the rejected claims predates the apparent effective dates of both Fazan and Nishioka.

In particular, the subject matter of the rejected claims was described in application serial number 08/044,331, and thus has benefits of its filing date of April 2, 1993. The subject matter of the '331 application was filed as continuation application 08/390,336, which issued as U.S. patent 5,578,772. At a minimum, Figure 10b of this patent supports the rejected claims. Thus, the rejected claims are entitled to an effective filing date of April 1993 .

In contrast, the effective date of Fazan (U.S. 5,392,189) is August 10, 1993, and the filing date of Nishioka (U.S. 5,489,548) is August 1, 1994. .

Therefore, contrary to the requirements of 35 USC 102(e), neither Fazan nor Nishioka were filed before the date of invention of the presently claimed invention. Accordingly, applicant respectfully request that the 102(e) rejections based on Fazan and Nishioka be withdrawn.

#### **Response to §103 Rejections**

Claims 48-55 were rejected under 35 USC §103(a) as unpatentable over Nishioka in view of Kaga (IEEE Electron Devices, Vol. 38(2), 1991, pp 255).

In response, applicant notes that Nishioka does not qualify as a reference against the present application on its later effective date. Accordingly, applicant respectfully requests that the §103 rejection be withdrawn.

#### **Request for Withdrawal of Finality**

Applicant respectfully notes that the present action included new rejections which were not necessitated by amendments made in the previous response. Indeed, the only amendments made in the previous response were the cancellation of claims 42, 43, 57, and 92. MPEP 706.07(a) states " the second or any subsequent actions on the merits shall be final, **except** where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)." Thus, the finality of the present action is premature.

Accordingly, applicant respectfully requests that the finality be withdrawn.

AMENDMENT & RESPONSE UNDER 37 C.F.R. § 1.116 - EXPEDITED PROCEDURE

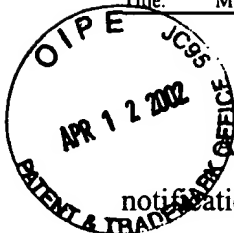
Serial Number: 09/489,954

Filing Date: January 24, 2000

Title: METHOD FOR FORMING A STORAGE CELL CAPACITOR COMPATIBLE WITH HIGH DIELECTRIC CONSTANT MATERIALS

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**Conclusion**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612 349-9593) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

1 April 2002

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Box AF, Commissioner of Patents, Washington, D.C. 20231, on this 1 day of April, 2002.

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